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		Application Number	10/525,268
		Filing Date	08/23/2005
		First Named Inventor	Andreas Poppe
		Art Unit	1713
		Examiner Name	HU
Total Number of Pages in This Submission		Attorney Docket Number	PAT-01050 (0906S-401)

### ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to Technology Center (TC)
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#### Remarks

The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 23-3425. A duplicate copy of this sheet is enclosed.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name Anna M. Budde	Reg. No. 35,085
Signature	<i>Anna M. Budde</i>		
Date	May 1, 2006		

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Signature	<i>Anna M. Budde</i>	Date	May 1, 2006

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EV 853 856 216 US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/525,268

Filing Date: August 23, 2005

Applicant: Andreas Poppe et al.

Group Art Unit: 1713

Examiner: Henry S. Hu

Title: Nanoparticles, Method for Modifying Their Surfaces, Dispersion of Nanoparticles, Method for the Production and the Utilization Thereof

Attorney Docket: BASF Docket No. PAT-01050  
Harness, Dickey & Pierce Docket No. 906-401

Director of the United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY TO RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action mailed April 10, 2006 in which a restriction requirement was made, Applicants respectfully elect the invention of Group I, to which claims 1-11, 20-24, 31, and 32 are directed.

Applicants respectfully make these elections with traverse of the restriction requirement..

Applicants respectfully traverse the restriction requirement between the inventions of Group I and Group II. Regarding the restriction requirement between the inventions of Group I and Group II, the Office Action states that in Group I the modifier

compound may cover the nanoparticles only physically, which Group II requires a chemical coupling reaction. Applicants respectfully point out that each of modifying groups (A), (B), and (C) is claimed as being "attached covalently to the surface via at least one linking functional group." Thus, the Office's interpretation of the claims of Group I is incorrect; the coverage must involve covalent attachment.

Applicants respectfully traverse the restriction requirement between the inventions of Group I and Group III. The Office Action states that the nanoparticles of claim 1 and the dispersion containing the nanoparticles of claim 1 do not share special technical features under PCT Rules 13.1 and 13.2. In fact, the claims of Group III incorporate all of the limitations of claim 1, the independent claim in Group I. The Office Action alleges that there is no special technical feature because no claim is patentable over the prior art, but this has not been shown and makes the restriction requirement (at best) premature.

Moreover, Applicants respectfully assert that restriction between the combination of Group III and subcombination of Group I requires both two-way distinctness and reasons for insisting on restriction. Two-way distinctness has not been shown, and the discussion in the Office Action of special technical features demonstrates that there is no serious search burden in examining both groups of claims.

Applicants respectfully traverse the restriction requirement between the inventions of Group I and Group IV for the same reasons as they traversed the restriction requirement between the inventions of Groups I and III. The invention of Group IV incorporates all of the features of claim 1. Further, Group I and Group IV are

related as combination/subcombination, and neither two-way distinctness nor serious search burden have been shown.

Group I has been elected with traverse. Applicants respectfully submit that the restriction requirement must be withdrawal of the for the above reasons. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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Anna M. Budde  
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May 1, 2006  
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